REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to claims 14 and 15 because the same depend from claim 1 which has been canceled. In response, claims 14 and 15 have been amended to depend from independent claim 2. Accordingly, it is respectfully requested that the objection to claims 14 and 15 be withdrawn.

In the Official Action, the Examiner rejects claims 2-7 and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,059,719 to Yamamoto et al., (hereinafter "Yamamoto") in view of U.S. Patent No. 6,068,063 to Suzuki (hereinafter "Suzuki"). Furthermore, the Examiner rejects claims 2-18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0053909 to Nakada et al., (hereinafter "Nakada") in view of Suzuki.[1]

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below.

With regard to Yamamoto and independent claims 2 and 13, Yamamoto teaches, at Figures 7 and 9, a configuration in which a loop portion (incising member) 93 of a high-frequency snare (incision device) 9a is inserted in a hood (main unit) 91 and the loop portion 93 is bent approximately at right angles with respect to the longitudinal direction of a transmission wire 22 of the high-frequency snare 9a. Further, at the distal end of the hood 91, a bent portion that is being bent inward approximately at right angles is illustrated in Figures 7 and 9.

[1] Although this rejection is made by combining the teachings of two prior art references, the Examiner has made the same under 35 U.S.C. § 102(b). Applicants submit that such a rejection is improper and assume that the Examiner meant to reject claims 2-18 under 35 U.S.C. § 103(a).

However, when using the device of Yamamoto, the loop portion 93 is placed around an organ by advancing the loop portion 93 of the high-frequency snare 9a while the organ is suctioned into the hood 91 as illustrated in Figure 10. Subsequently, the loop portion 93 is made smaller by pulling the transmission wire 22 of the high-frequency snare 9a, thereby fastening the organ.

Accordingly, in the device of Yamamoto, the bent portion of the distal end of the hood 91 is not particularly engaged with the loop portion 93 of the high-frequency snare 9a. Therefore, it has a different configuration from that of the medical instrument system and method of assembling a medical instrument system recited in claims 2 and 13, respectively, which carries out the looping operation by setting the loop portion of the high-frequency snare so that it is arranged along the flange-shaped projection inside the hood. As a result, the device of Yamamoto is incapable of appropriately fastening the loop portion 93 at the root of the organ.

Further, as pointed out by the Examiner, Yamamoto does not suggest a configuration that corresponds to the distal-end bent portion (7; 22; 52) provided at the distal-end portion of the loop portion (5) as recited in claims 2 and 13.

As the configuration of Yamamoto and that recited in claims 2 and 13 completely differ, claims 2 and 13 patentably distinguish over that which is disclosed in Yamamoto.

With regard to Suzuki and independent claims 2 and 13, Suzuki teaches a configuration in which a loop portion (expansible section) 16a of a snare 16 is bent at an inclined angle with respect to the rear support section. However, Suzuki's device is provided with a flat section 21 at the distal end of a snare pipe 18 that guides the movement of the snare

16. By engaging the root of the loop portion 16a of the snare 16 into this flat section 21, the rotation of the loop portion 16a of the snare 16 is controlled. In this manner, the loop portion 16a of the snare 16 is prevented from rotating with respect to a sheath 9 when the bent portion of the loop portion 16a of the snare 16 projects from the snare pipe 18. As a result, when the sheath 9 rotates, the bent portion of the loop portion 16a of the snare 16 conforms thereto, and the loop portion 16a of the snare 16 is positioned in accordance with the direction of the distal-end opening 17b of the sheath 9.

Therefore, Suzuki simply does not teach a configuration in which the bent portion of the loop portion 16a of the snare 16 is engaged with other members.

As the configuration of Suzuki and that recited in claims 2 and 13 completely differ, claims 2 and 13 patentably distinguish over that which is disclosed in Suzuki.

With regard to claims 2 and 13 and the combination of Suzuki and Yamamoto, the medical instrument system and method of assembling a medical instrument system recited in claims 2 and 13, respectively, have a configuration in which the loop section (e.g., 5) is positioned in a state where a distal-end bent portion (e.g., 7; 22; 52) overlaps an angular shape of the bent portion of the projection (e.g., 13; 40; 67) when the loop section expands along the inner circumference surface of the projection (e.g., 13; 40; 67). However, such features are neither disclosed nor suggested in either Yamamoto or Suzuki.

Thus, even in the case of combining Yamamoto and Suzuki, such a combination does not disclose or suggest each and every limitation of independent claims 2 and 13.

With regard to the rejection of claims 2-7 and 11-13 under 35 U.S.C. § 103(a), independent claims 2 and 13 are not rendered obvious by the cited references because neither

the Yamamoto patent nor the Suzuki patent, whether taken alone or in combination, teach or suggest a medical instrument system having the features discussed above and recited in independent claim 2 and a method of assembling a medical instrument system having the features discussed above and recited in independent claim 13. Accordingly, claims 2 and 13 patentably distinguish over the prior art and are allowable. Claims 3-7 and 11-12, being dependent upon claim 2, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 2-7 and 11-13 under 35 U.S.C. § 103(a).

With regard to Nakada and independent claims 2, 13 and 16, as pointed out by the Examiner, Nakada does not teach a configuration which corresponds to the distal-end bent portion (7; 22; 52) provided at the distal-end portion of the loop section (5) as recited in claim 2.

With regard to Suzuki and claims 2, 13 and 16, the same has been discussed above.

With regard to the combination of Nakada and Suzuki and claims 2, 13 and 16, claims 2, 13 and 16 recite a configuration in which the loop section (5) is positioned in a state where a distal-end bent portion (7; 22; 52) overlaps an angular shape of the bent portion of the projection (13:40; 67) when the loop section expands along the inner circumference surface of the projection (13; 40; 67). However, such features are neither disclosed nor suggested in either Nakada or Suzuki.

Thus, even the combination of Nakada and Suzuki does not disclose or suggest each and every feature of claims 2, 13 and 16.

With regard to the rejection of claims 2-18 under 35 U.S.C. § 103(a), independent claims 2, 13 and 16 are not rendered obvious by the cited references because neither the Nakada patent nor the Suzuki patent, whether taken alone or in combination, teach or suggest a medical instrument system having the features discussed above and recited in independent claim 2; a method of assembling a medical instrument system having the features discussed above and recited in independent claim 13 and a diathermic snare having the features discussed above and recited in independent claim 16. Accordingly, claims 2 and 13 patentably distinguish over the prior art and are allowable. Claims 3-7 and 11-12, being dependent upon claim 2, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 2-7 and 11-13 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm